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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/856,740	01/09/2002	Nathalie Monfreux-Gaillard	MIDR700	3768

27551 7590 12/18/2003

STEPHEN H. CAGLE  
HOWREY SIMON ARNOLD & WHITE LLP  
750 BERING DRIVE  
HOUSTON, TX 77057

EXAMINER

WILSON, DONALD R

ART UNIT PAPER NUMBER

1713

DATE MAILED: 12/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/856,740

Applicant(s)

MONFREUX-GAILLARD ET AL.

Examiner

Donald R Wilson

Art Unit

1713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 11/14/03.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) 1-12, 15-18 and 23-40 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 13, 14, 21 and 22 is/are rejected.
- 7) ☒ Claim(s) 19 and 20 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

**DETAILED ACTION**

***Response to Restriction Requirement***

1. Applicant's election with traverse of the inventions of Group II, Claims 13-22 in Paper No. 11 is acknowledged. The traversal is on the ground(s) that an examination of all of the claims would not be an undue burden. This is based upon an allegation that a search for the elected Group II invention will necessarily require a search in the classes that include the other groups. This is not found persuasive because the allegation is not supported by any facts. Further, the entire prosecution of the application is to be considered not just the initial search.
2. The requirement is still deemed proper and is therefore made FINAL. Claims 1-11 and 23-40 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention.
3. Applicant is reminded that if claims directed to the product are elected, and a product claim is subsequently found allowable, withdrawn process claims which depend from or otherwise include all the limitations of the allowable product claim will be rejoined. See M.P.E.P. § 821.04.

***Response to Election of Species Requirement***

4. Applicant's election of the following species in the same Paper No. 11 is acknowledged:
  - a. polyacrylic acid as the hydrophilic polymer that is modified, i.e., the polymer backbone,
  - b. di-n-dodecylamine as the n-alkyl amine used to modify the polymer backbone,
  - c. hexadecane as the oleaginous fluid,
  - d. 20% aqueous calcium chloride solution as the non-oleaginous fluid, and
  - e. an invert emulsion.

Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

5. Claims 15-18 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected specie of the invention. Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 C.F.R. § 1.141.

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***Claim Rejections - 35 USC § 112, Second Paragraph***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. ~~Claims 14 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the~~

~~invention.~~ Claim 14 is indefinite because the language of the Markush group is not understood commencing with "any other alkyl derivative substituted in the B position ----". First it is unclear what is meant by the "B-position" and secondly it isn't seen how or what alkyl derivatives are obtained with the indicated reagents as they are not alkylating agents. The language also indicates that the obtained with applies to all of the following compounds which is perhaps not applicant's intention. Also note that applicant probably meant "mono-" as opposed to "mon-". Applicant should also use one of the accepted formats for Markush groups, i.e.,

When materials recited in a claim are so related as to constitute a proper Markush group, they should be recited in the conventional manner, or in the alternative. For example, "wherein R is a material selected from the group consisting of A, B, C and D" is a proper limitation, or alternatively, "wherein R is A, B, C or D" is also proper. See M.P.E.P. § 2173.05(h).

It is suggested based upon language on page 4 of the specification that "---- selected from the group consisting of acrylic acid, methacrylic acid,  $\beta$ -alkylacrylic acids, mono- or polyalkylene glycol esters of acrylic, methacrylic or  $\beta$ -alkylacrylic acids, acrylamide, methacrylamide, vinylpyrrolidone, itaconic acid, maleic acid, 2-acrylamido-4-sulfonic acid and vinyl sulfonic acid" would be a clearer and better definition of the monomers.

***Claim Rejections - 35 USC § 102(b)/§ 103(a)***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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9. Claims 13-14 and 21-22 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Fong.

10. Fong discloses water-in-oil emulsions of acrylate copolymers containing acrylic acid units and 0.1 to 15 mole % of an N-alkylacrylamide units wherein the alkyl group has preferably at least 12 carbon atoms (Claim 1, col. 5, lines 12-33). The polymers have preferred molecular weights of 500,000 and most preferably one million or more (col. 2, lines 43-50). The oleaginous phase is taught to include low odor paraffinic solvents which would be expected to include the elected specie of hexadecane (col. 6, lines 6-21).

***Allowable Subject Matter – Dependent Claims***

11. Claims 19-20 would be allowable if rewritten to include all of the limitations of the base claim and any intervening claims. No prior art has been found of emulsion compositions of oleaginous and non-oleaginous fluids comprising a polymeric surfactant with a hydrophilic backbone which has been amidified by di-n-alkyl amines.

***Art of Interest/Technological Background***

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Williamson incorporates by reference the teachings of Fong and is considered to be cumulative to Fong.


***Future Correspondence***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald R Wilson whose telephone number is 703-308-2398 (571-272-1113).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on 703-308-2450 (571-272-1114). The fax phone numbers for the organization where this application or proceeding is assigned is (703) 872-9306 for regular communications. The unofficial direct fax phone number to the Examiner's desk is 703-872-9029 (571-273-1113).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 308-2351.

The Examiner is expected to move to the new Office about Christmas time. New telephone numbers known to the Examiner are indicated in parentheses.

  
DONALD R. WILSON  
PRIMARY EXAMINER